

REMARKS

The issues outstanding in the Office Action mailed July 6, 2007, are the rejections under 35 U.S.C. 112, 102, 103 and the doctrine of obviousness-type double-patenting. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

Rejection Under 35 U.S.C. 112

Claims 6, 7 and 9 have been rejected under 35 U.S.C. 112, second paragraph, as indefinite. It is noted at page 2 of the Office Action that various formulae are not defined. Correction of the dependencies of these claims obviates this issue, and withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. 102 and 103

Claims 1-10 have been rejected under 35 U.S.C. 102(b) or in the alternative 103, over commonly owned DE 101 35 499 (DE'499). Reconsideration of this rejection is respectfully requested.

As noted at page 3 of the Office Action, the reference discloses indane compounds Ia, in which, in the generic formula, there are three possibilities, for W (see page 3, lines 19 and 23 of the German) and seven possibilities for X. Moreover, n can be 0-4. As a result, the generic formula of the reference encompasses compounds having a different ring structure, as well as considerably different substitution on the rings, verses the presently claimed compounds as used in liquid crystalline media. Moreover, the specific compounds highlighted at page 3 of the Office Action are also significantly structurally different from the presently claimed materials. For example, the second formula at page 5 of the reference has an additional cyclohexyl ring. The compound disclosed at pages 10-13 of the reference do not have the same ring structure as the present compounds. Accordingly, it is submitted that this reference does not anticipate the present claims.

Moreover, it is submitted that the reference fails to suggest the presently claimed compounds. The present situation is quite similar to that of *In re Jones*, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992), in which the Federal Circuit held that a generic formula, along with examples each of which contained a feature of the claims, but lacking other features, *did not* suggest later claimed compounds in the absence of some instruction to one of ordinary skill in the art as to why the specific features selected from each example would be employed together in a single compound. In the present situation, the generic formula along with examples which are structurally diverse from the present claims, fail to suggest the claimed compounds. Withdrawal of the rejection under 35 U.S.C. 103 is therefore also respectfully requested.

Claims 1-10 have been rejected under 35 U.S.C. 102(e) over U.S. 2004/017866 (Rieffenrath et al.), commonly assigned. Reconsideration of this rejection is respectfully requested.

It is respectfully submitted that the Rieffenrath patent is *not* a reference under 35 U.S.C. 102(e), in as much as the PCT international application was *not* published in English. See MPEP §706.02(f)(1) (“if the international application was filed on or after November 29, 2000, but did not designate the United States or was not published in English...do not treat the international filing date as a U.S. filing date for prior art purposes. In this situation, do not apply the reference as if its international filing date, its date of completion of the 35 U.S.C. 371 (c) (1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority.”) Accordingly, withdrawal of the rejection under 35 U.S.C. 102(e) is respectfully requested.

Claims 1-10 have been rejected under 35 U.S.C. 103 over EP’780, U.S. 2003/0222243 or U.S. Patent 7,182,885 (all essentially equivalent). Reconsideration of each of these rejections is respectfully requested.

EP’780

As noted at page 4 of the Office Action, formula I of the reference is an *indene* compound. Specifically, this is a fused ring wherein *both* rings are unsaturated. It is argued that one of ordinary skill in the art would know that these compounds could be further hydrogenated to arrive at the saturated compounds of the present claims. However, it is submitted that such is far more than a “slightly different structure” and, further, that one of ordinary skill in the art lacks

the motivation to do so, in view of the teaching in the reference that the unsaturated compounds are “well suited” in use for liquid crystal media (see paragraph 0001 of EP’780 and, for example, paragraph 0023 of the U.S. ‘243 publication.) The mere fact that the compounds *can be* saturated does not provide one of ordinary skill in the art any motivation to do so, in the absence of at least some expectation of how the properties of the WO’866 compounds would be affected. Since the ‘866 compounds are taught to be suitable, there is no motivation for such a modification.

With respect to the U.S. application and U.S. patent equivalent to the EP, it is noted that the rejection made is under 35 U.S.C. 103. In as much as the U.S. application and patent were subject to an obligation to assign to the owner of the present application, at such time as both inventions were made, these references are not available under 35 U.S.C. 102(e)/103, and withdrawal of the rejection thereover is respectfully requested. With respect to the U.S. publication, available as of December 4, 2003, the disclosure also does not suggest the present compounds, in view of the discussion of the EP’780 above. Withdrawal of this rejection is therefore respectfully requested.

Accordingly, it is submitted that none of the cited references suggests or anticipates the present claims, withdrawal thereof is respectfully requested.

Double Patenting

Claims 1, 4, 8 and 10 have been rejected under the doctrine of obviousness-type double patenting over claims 4 and 5 of U.S. Patent 7,122,228. This rejection is moot, in view of the accompanying Terminal Disclaimer.

Claims of the application are submitted in condition for allowance. However, if the Examiner has any questions or comments, he or she is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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